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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/777,131

02/13/2004

Brigitte Gicquel

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22852

7590

07/18/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
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EXAMINER

SWARTZ, RODNEY P

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/777,131	GICQUEL, BRIGITTE	
	Examiner	Art Unit	
	Rodney P. Swartz, Ph.D.	1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26,28,29,31-43 and 45-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 32-43 and 45-52 is/are allowed.
- 6) ☒ Claim(s) 26,28,29 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's Response to Office Action, received 17 April 2006, is acknowledged. Claims 1-25, 27, 30, and 44 have been canceled. Claims 26, 28, 29, 31-35, 42, and 45 have been amended. New claims 46-52 have been added.
2. Claims 26, 28, 29, 31-43, and 45-52 are pending and under consideration.

Rejections/Objections Moot/Withdrawn

3. The objection to claim 42 is withdrawn in light of the amendment of the claim.
4. The rejection of claims 27 and 30 under 35 U.S.C. 101 is moot in light of the cancellation of the claims.
5. The rejection of claims 26, 28, 29, and 31 under 35 U.S.C. 101 is withdrawn in light of the amendment of the claims.
6. The rejection of claims 27 and 30 under 35 U.S.C. 112, second paragraph, as being indefinite, is moot in light of the cancellation of the claims.
7. The rejection of claim 30 under 35 U.S.C. 112, second paragraph, as being indefinite, is moot in light of the cancellation of the claim.
8. The provisional rejection of claims 27 and 30 under 35 U.S.C. 101 as claiming the same invention as that of claims 26-43 and 45 of copending Application No. 10/216,817, is moot in light of the cancellation of the claims.
9. The rejection of claims 26 and 29 under 35 U.S.C. 112, second paragraph, as being indefinite, is withdrawn in light of the amendment of the claims.
10. The rejection of claims 32 and 45 under 35 U.S.C. 102(e) as being anticipated by Fleischmann et al (U.S. Pat. No. 6,294,328), is withdrawn in light of the claim amendments to recite "consisting of".

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11. The rejection of claims 34 and 35 under 35 U.S.C. 112, second paragraph, as being indefinite, is withdrawn in light of the amendments of the claims.

12. The provisional rejection of claims 26, 28, 29, 31-43, and 45 under 35 U.S.C. 101 as claiming the same invention as that of claims 26-43 and 45 of copending Application No. 10/216,817, is withdrawn in light of the cancellation of claims 26-43 and 45 of copending Application No. 10/216,817.

New Rejections Necessitated by Amendment

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 26, 28, 29, and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 26 is drawn to a purified polynucleotide "comprising an open reading frame" of the *Rv3908* gene. However, the specification recites that *Rv3908* is an ORF. Therefore, the use of open language, "comprising an open reading frame of", is unclear is that the claim connotes that *Rv3908* contains more than just one ORF. Is the claim drawn to *Rv3908* or a sequence larger than *Rv3908*? Claim 28 depends from claim 26, but does not clarify the indefiniteness.

Claim 29, as with claim 26, is drawn to a purified polynucleotide "comprising an open reading frame of the *MutT2* gene". However, the specification recites that *MutT2* is an ORF. Therefore, the use of open language, "comprising an open reading frame of", is unclear is that the claim connotes that *MutT2* contains more than just one ORF. Is the claim drawn to *MutT2*

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or a sequence larger than *MutT2*? Claim 31 depends from claim 29, but does not clarify the indefiniteness.

Conclusion

15. Claims 26, 28, 29, 31 are finally rejected. Claims 32-43 and 45-52 appear to be free of the prior art.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

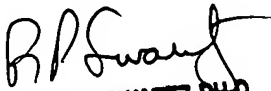
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney P. Swartz, Ph.D., Art Unit 1645, whose telephone number is (571) 272-0865. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F. Smith, can be reached on (571)272-0864.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


RODNEY P SWARTZ, PH.D
PRIMARY EXAMINER

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July 10, 2006